

REMARKS

Claims 1, 6-11, 13, and 15-25 are currently pending. Claims 12 and 14 have been canceled without prejudice or disclaimer. Claims 13, 15, 16, 19, 22, and 23 have been amended.

New independent claims 24 and 25 have been added to protect an invention the Applicant wishes to protect. No new matter has been added. Claims 1, 24, and 25 are the sole independent claims.

35 USC §103 Rejections

Claims 1, 6-11, 12-17, 19-20 and 22-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over International Application WO 98/09006 to Bjerrum, et al. (the Bjerrum reference).

Claims 11, 18 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Bjerrum reference in view of U.S. Patent Nos. 4,517,030 to Yamamoto et al. (the Yamamoto reference) and 5,152,849 to Bittner et al. (the Bittner reference).

Claims 1, 6, 8, 12, 14, 16, 19 and 22-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,645,706 to Matsuda (the Matsuda reference).

Claims 11, 18 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Matsuda reference in view of the Yamamoto reference and the Bittner reference.

Where not rendered moot by amendment, Applicant respectfully traverses these rejections. As discussed below, Applicant submits that no *prima facie* case of obviousness has been presented, and therefore the Examiner's burden has not been met.

Moreover, neither the Bjerrum reference nor the Matsuda reference, teach or suggest the unique combination of parameters required by Applicant's independent claims which result in a nonsludging zinc phosphate treatment liquid composition.

The Bjerrum reference

The Examiner has indicated that the disclosed ranges in the Bjerrum reference encompass the claimed ranges. The MPEP §2144.08 states that “[t]he fact that a claimed species^[1] or subgenus [or distinct compositions are] **encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness.**”

While it is possible that there are theoretical numbers within the ranges disclosed by the Bjerrum reference that might satisfy the Applicant's claimed equations, that does not render the present claims obvious because there are also many theoretical numbers within the ranges that would not satisfy the Applicant's claimed equations. For example, *none* of the examples in the Bjerrum reference meets the limitations of independent claims 1, 24, or 25.

Thus, there must be some teaching or suggestion in the reference that allows one to ignore the teachings of the exemplified compositions, and somehow separate the combinations that might satisfy the claims from the ones that do not. No such teaching or suggestion exists. Such theoretical numbers can only be found by hindsight - picking and choosing throughout the ranges such numbers as satisfy Applicant's equations. This, of course is impermissible.

¹ If a reference's disclosed range is *so broad as to encompass a very large number of possible distinct compositions*, this might present a situation analogous to the obviousness of a species when the prior art broadly discloses a genus. MPEP § 2144.05

Applicant has not invented zinc containing compositions, but rather compositions that satisfy certain equations, such compositions having the benefit of being non-sludging. Any proper analysis of obviousness must address Applicant's equations specifically. This is particularly true as the Bjerrum reference **fails to exemplify any compositions which satisfy those equations.** In other words, if one skilled in the art relied on the examples of the Bjerrum reference, they could not arrive at the claimed invention. Thus, the Bjerrum reference is more likely to teach away from Applicant's claims than towards them. This highlights the nonobviousness of the Applicant's invention with respect to the Bjerrum reference.

As no *prima facie* case was established, the rejection is improper. Withdrawal of the rejection is respectfully requested. The dependent claims depend from and further limit independent claims that distinguish over the Bjerrum reference, and therefore distinguish over it as well.

The Matsuda reference

The Examiner has indicated that the disclosed ranges in the Matsuda reference encompass the claimed ranges. Again, the MPEP §2144.08 states that “[t]he fact that a claimed species or subgenus [or distinct compositions are] encompassed by a prior art genus *is not sufficient by itself to establish a prima facie case of obviousness.*” As with the Bjerrum reference, there is simply no suggestion or motivation in the Matsuda reference to arrive at the unique combination of parameters required by Applicant's independent claims.

None of examples in the Matsuda reference meets the limitations of independent claims 1, 24, and 25. Possibly, combinations of ranges disclosed by the Matsuda reference

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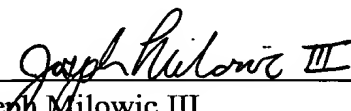
satisfy the Applicant's claimed equations, but that does not render the present claims obvious. As stated above, Applicant has invented compositions that satisfy certain equations, such compositions enjoying the benefit of being non-sludging. Any proper analysis of obviousness must address Applicant's equations specifically.

The Matsuda reference **fails to exemplify any compositions which satisfy those equations**. If one skilled in the art relied on the examples of the Matsuda reference, they could not arrive at the claimed invention. Thus, the Matsuda reference is more likely to teach away from Applicant's claims than towards them. This highlights the nonobviousness of the Applicant's invention with respect to the Matsuda reference.

As no *prima facie* case was established, the rejection is improper. Withdrawal of the rejection is respectfully requested. The dependent claims depend from and further limit independent claims that distinguish over the Matsuda reference, and therefore distinguish over it as well.

If the Examiner has any questions, she is encouraged to call the undersigned.

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